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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/915,421 | 07/27/2001 | Ryosuke Miyamoto | 35.G2869 | 7005 |

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EXAMINER

LU, TOM Y

ART UNIT PAPER NUMBER

2621

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,421

Applicant(s)

MIYAMOTO, RYOSUKE

Examiner

Tom Y Lu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-46 is/are allowed.
- 6) ☒ Claim(s) 47-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 47-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Naito et al (U.S. Patent No. 6,628,417 B1).

- a. Referring to Claim 47, Naito teaches first receiving means (center server 102, see figure 1) that receives forgery-preventing capability data from each of the plurality of image reading devices and each of the plurality of image output devices (center server 102 is in communication with image reading devices, image servers 111~11N, and output devices, printer servers 121~12N, see figure 1. center server 102 receives information about image servers having the watermarking detecting/editing capability, column 11, lines 4-10, and information about printer servers having the capability of printing/removing such watermarks, column 12, lines 62-66 and column 13, lines 40-43); second receiving means (client computer 101) that receives image data read by one of the plurality of image reading devices (column 10, lines 2-5); and controlling means that controls processing of the image data received by the second receiving means to output the image data to an appropriate image output device based on whether or not the

image reading device that read the image data includes a forgery-preventing capability (client computer 101 generates a print order to the center server, which sends the select image with watermark to a printer server with watermark printing capability, column 10, lines 6-9).

- b. Referring to claim 48, Naito teaches wherein said controlling means outputs the image data to an output device that includes a forgery preventing capability if the image reading device that read the image data does not include a forgery-preventing capability (see figure 15, printer registration image means 704 detect the watermark is not embedded in the original image S1509, which is usually done by an image server, printer registration image means embeds the watermark).
- c. Referring to claim 49, Naito teaches notifying means that notifies a user by a warning when the forgery-preventing capability of an image reading device or an image output device judges the image data is data of a specific image (column 33, lines 45-48, the copyright holder is notified whether or not to a watermark should be embedded).
- d. Referring to claim 50, Naito teaches wherein the data of the specific image is information expressing a specific pattern or a digital watermark (column 33, line 49).
- e. Referring to claim 51, Naito teaches wherein the first receiving means receives the forgery-preventing capability data when the image processing apparatus is turned on (once the image servers are turned on, the center server 102 on the same

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network is notified, and the center server receives the forgery-preventing capability data of since the image server is turned on, the watermarking capability of the image server is available).

- f. Referring to claim 52, Naito teaches wherein the first receiving means receives the forgery-preventing capability data when at least one of the image reading devices or at least one of the image output devices is changed (if one of the image servers or printer servers is disconnected from the network, the center server is notified, which is an inherent feature of any network, accordingly, the center server will receive the forgery-preventing data of the watermarking capability of the disconnected server is no longer available).
- g. Referring to Claim 53, Naito teaches wherein the first receiving means receives the forgery-preventing capability data when at least one of the image reading devices or at least one of the image output devices receives a reading or an image output indication from the image processing apparatus (center server receives the requested image along with watermark data when a request is sent to the image server, column 10, lines 58-59 and column 11, lines 3-4).
- h. Referring to Claim 54, Naito teaches wherein the first receiving means receives the forgery-preventing capability data when a new image reading device or a new image output device is connected to the image processing apparatus via a network (when an image server or printer server is connected to the network, the center server is notified the presence of the server, which is an inherent feature. Since both image server and printer server have the watermarking capability, such

capability is understood by the center server when the image server or printer server is connected to the network).

- i. Referring to Claim 55, Naito teaches wherein the controlling means outputs the image data to an output device selected by an operator of the image processing apparatus if the image reading device that read the image data includes a forgery-preventing capability (based on the fee paid by the user, the type of printer is selected, column 16, lines 42-43, and the printer includes a watermarking capability as mentioned above).
- j. With regard to Claim 56, see explanation in Claim 47.

Allowable Subject Matter

- 2. The following is a statement of reasons for the indication of allowable subject matter:
 - a. Independent Claims 1, 11, 22, 23, 24, 25, 26 and 36 all define steps of receiving information from a first scanning apparatus indicating the presence of a forgery-preventing function in the first scanning apparatus, and receiving information from a second scanning apparatus indicating the absence of a forgery-preventing function in the second scanning apparatus; receiving information from a first printing apparatus indicating the presence of a forgery-preventing function in the first printing apparatus, and receiving information from a second printing apparatus indicating the absence of a forgery-preventing function in the second printing apparatus. These functional steps in combination with other steps in Claims 1, 11, 22, 23, 24, 25, 26 and 36, which are the broadest allowable claims, are not taught or suggested by the art of record.

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- b. Claims 2-10 are dependent upon Claim 1.
- c. Claims 12-21 are dependent upon Claim 11.
- d. Claims 27-35 are dependent upon Claim 26.
- e. Claims 37-46 are dependent upon Claim 36.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Yamaguchi et al U.S. Patent No. 5,390,003, see abstract and figure 1.
- b. Hasegawa, U.S. Patent No. 6,515,755 B1, see figure 1, column 2.
- c. Kakiuchi et al, U.S. Patent No. 6,687,017 B1, see abstract.
- d. Ohkubo, U.S. Patent No. 5,123,063, see columns 1 and 2.

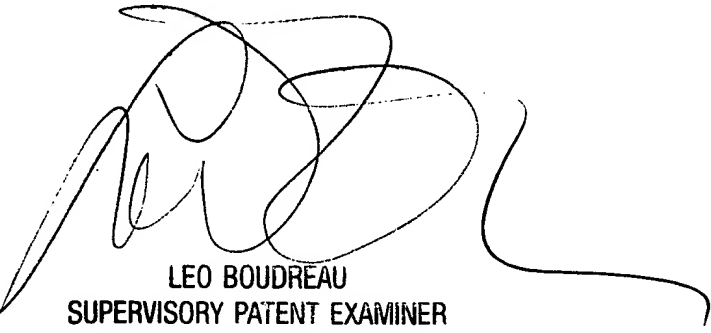
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Y Lu whose telephone number is (703) 306-4057. The examiner can normally be reached on 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on (703) 305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tom Y. Lu



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